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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,847	07/22/2003	Ioana M. Rizoju	BI9322CON	6537

7590 03/24/2005
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EXAMINER

LEWIS, RALPH A

ART UNIT PAPER NUMBER

3732

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/624,847	Applicant(s) RIZOIU ET AL.	
	Examiner Ralph A. Lewis	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 29-87 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 29-87 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Objection to the Specification

This application filed under former 37 CFR 1.60 lacks the necessary reference to the prior application. A statement reading "This is a Continuation of Application No. 10/624,847, filed November 15, 2001, now US Patent 6,616,447." should be entered following the title of the invention or as the first sentence of the specification. Also, the current status of all nonprovisional parent applications referenced should be included.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). The specification provides no apparent antecedent basis for the "dental strip" language of claim 66.

Obvious-type Double Patenting Rejections

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Ralph A. Lewis
Primary Examiner

Claims 1 and 29-87 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,616,447. Although the conflicting claims are not identical, they are not patentably distinct from each other because one of ordinary skill in the art would have found the present claims obvious in view of those already patented. For example it would have been obvious to one of ordinary skill in the art to have referred to the "dental tape" of patented claim 1 as a dental band and the light source more broadly as an "electromagnetic energy emitting element." The variations between the patented claims and those presently pending are obvious variations of one another.

Rejections based on Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 29-31, 34-37, 40, 41, 43, 45, 47, 48, 61, 63, 66-68, 71-75, 80-84, 86 and 87 are rejected under 35 U.S.C. 102(e) as being anticipated by Jensen et al (US 6,391,283).

Jensen discloses a dental band/strip 40 that is applied and temporarily attached to a patient's tooth and electromagnetic energy emitting elements 44. In regard to claim 34 and 61, note the "heat lamp" disclosure of Jensen et al (column 19, line 42). In regard to claim

It is noted that applicant's specification only briefly refers to the terms "dental band" and "dental tape" in passing (e.g. column 7, line 51 of the parent 6,616,447) without providing for any real definition of the terms. The examiner interprets the terms as requiring a thin elongated structure. The "tape" terminology is further interpreted as having an inherent flexibility requirement which is not necessarily present in the term "band."

Claims 1, 29-33, 35-37, 63, 65-68, and 71 are rejected under 35 U.S.C. 102(b) as being anticipated by Kipke et al (US 5,487,662).

Kipke et al disclose a band/strip 12 that is applied and temporarily attached to a patient's teeth having LEDs 164 and woven fiber optics 156, 158. In regard to claims 63 and 65, note transparent panel 24 which acts to diffuse light

Claims 1 and 59 are rejected under 35 U.S.C. 102(b) as being anticipated by Oxman et al (US 5,718,577).

Note the abstract.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 42, 44, 46, 62, 69 and 79 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen et al (US 6,391,283).

In regard to claims 42, 44 and 46, Jensen doesn't explicitly disclose the use of a gel or fluoride, however, the use of such conventional dental treatment compositions with the Jensen device while treating the teeth for whitening would have been obvious to one of ordinary skill in the art in order to make the teeth healthier. In regard to claims 62 and 69, to have provided a switch on the Jensen et al device so that the brightness could be set to the desired level would have been obvious to one of ordinary skill in the art.

Claims 32, 67 and 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jensen et al (US 6,391,283) in view of Kipke et al (US 5,487,662).

Kipke et al teaches the use of a woven fiber optic panel (figure 7) for distributing light throughout the Kipke et al band. To have interganged a prior art woven panel for the solid panels 40 of Jensen would have been obvious to one of ordinary skill in the art as the substitution of equivalent known structures.

Prior Art

Wang (US 4,553,936), Hammesfahr et al (US 4,867,682), Hare (US 5,316,473), Montgomery et al (US 6,162,055), Nikodem (US 5,813,854), Darnell (US 6,254,391), Lindquist (US 6,382,979), Cipolla (US 6,416,319), Jacob (US 6,077,073) and Lindquist (US 6,533,582) are made of record.

Allowable Subject Matter

Claims 38, 39, 49-58, 60, 70 and 76-78 would be allowable upon the filing of a terminal disclaimer to overcome the obvious-type double patenting rejection above and if rewritten in independent form to include all of the limitations of the claims from which they depend.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(571) 272-4712**. Fax (703) 872-9306. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Kevin Shaver, can be reached at (571) 272-4720.

R.Lewis
March 18, 2005



Ralph A. Lewis
Primary Examiner
Aw3732